Patent
TS-7564 (US)

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Yukiko Iwata

Date: September 24, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re application of	)	
ANDREW JOHN HOLMES and CAMERON WILLIAM WATSON	)	
Serial No. 09/648,325	)	Group Art Unit 1764
Filed August 25, 2000	)	Examiner J. D. Johnson
HYDRAULIC FLUID	)	September 24, 2003

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

This reply brief is submitted in triplicate in further response to arguments made by the Examiner in the Examiner's Answer.

The Examiner erred in asserting that "it would have been obvious to include an overbased alkylsalicylate in a hydraulic fluid as taught by Matthew et al.; said fluid to be used in an acidic environment" and "it would have been obvious . . . to include a compound

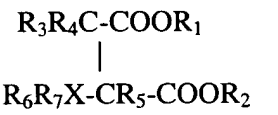
of formula I as taught by Matthew et al. in the lubricating composition of Fujitsu et al. because Fujitsu et al. specifically teach the addition of such compounds."

Applicants maintain that the applicants' composition is novel and unobvious. Applicants claim a hydraulic fluid comprising a lubricant base oil in combination with

(a) from 0.001 to 5 %wt of magnesium salicylate,

(b) from 0.01 to 8 %wt of zinc dithiophosphate; and,

(c) from 0.001 to 5 %wt of a compound according to the following formula I



(formula I)

in which R_1 and R_2 are each hydrogen or alkyl or hydroxyalkyl of 1 to 30 carbon atoms; R_3, R_4 and R_5 are each hydrogen or alkyl or hydroxyalkyl of 1 to 4 carbon atoms; X is CH or N and R_6 and R_7 are each hydrogen, alkyl or alkenyl of 1 to 30 carbon atoms, or an acyl group derived from a saturated or unsaturated carboxylic acid of up to 30 carbon atoms.

Applicants have found that the specific combination provide improved performance at low load compared with a combination containing calcium salicylate. (see page 3, lines 26-33 and page 4, lines 1-3) It also provides greater thermal stability and less sludge and deposits formed. As can be seen at Table 1, the comparative composition containing calcium salicylate (Composition 2) has significantly more ring weight loss and total weight loss than the composition as claimed in the present application containing magnesium salicylate (Composition 1). Examiner's argument suggests the use of an "obvious to try" standard. The Court of Appeals for the Federal Circuit has stated that this is not the proper test for determining obviousness under § 103. A showing of obviousness requires a motivation or suggestion to combine or modify prior art references, *coupled with a reasonable expectation of success.* See, Brown & Williamson Tabacco Corp. v. Philip Morris Inc., 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000). A general incentive does not make obvious a particular result. For example, Fujitsu reference does not provide for the selection of magnesium salicylate rather than calcium salicylate. Further, there is no motivation or

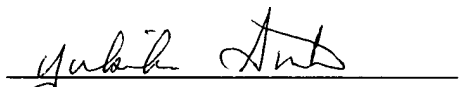
suggestion to combine components taught by Mathews, EPA '464 and Karn to result in applicants' claimed composition with a reasonable expectation of success. Here, applicants claims a hydraulic fluid comprising a lubricant base oil with the particular combination with magnesium salicylate, zinc dithiophosphate; and, a compound of formula I to obtain improved performance at low load, thermal stability, and less sludge and deposits formation.

CONCLUSION

For the reasons set forth above, Applicants assert that the rejections made by the Examiner are improper. Applicants therefore respectfully request that the Board reverse the Examiner's rejections.

Respectfully submitted,

ANDREW JOHN HOLMES and
CAMERON WILLIAM WATSON



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